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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,416	07/19/2000	Lynn Van Erden	SYMXP002	2643
47472	7590	04/05/2005	EXAMINER	
RITTER, LANG & KAPLAN LLP - P.O. BOX 2448 SARATOGA, CA 95070			HANDY, DWAYNE K	
			ART UNIT	PAPER NUMBER
			1743	
DATE MAILED: 04/05/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/619,416

Applicant(s)

ERDEN ET AL.

Examiner

Dwayne K. Handy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17,19-26,31-50 and 54-56 is/are pending in the application.
- 4a) Of the above claim(s) 31-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17,19-26,42-50,54-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Drawings***

1. Drawings showing the check valves (Figure 14) were received on 5/10/2004.

These drawings were objected to in the previous action, but are now approved in light of applicant's arguments submitted 12/27/2004.

### ***Inventorship***

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 17, 19-25, 42-49 and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bisconte (5,190,666) in view of Kilcoin et al. (6,190,619). Bisconte teaches a method and apparatus for filtering a plurality of samples. The device is best shown in Figure 2 and described in detail in columns 4 and 5. The device of Bisconte includes a base (20) with wells (19) for holding samples, cover(1), and inlet port (28) for pressurizing the chamber (27) containing the wells (19). Bisconte does not teach a flow restriction device having a plurality of passageways configured to provide fluid communication with each of the wells while reducing cross talk between the wells. Bisconte instead teaches a plate (13a) that holds the pipes (12a) and the dip tubes (21) as well as also containing an additional perforation for pressurizing the wells (column 5, lines 45-55).

Kilcoin teaches a system for the parallel synthesis of compounds. The system includes a fluid manifold system for delivering and removing fluids from the reactors (column 7, line 49 – column 8, line 31). The fluid manifold contains both a rigid portion (38) as well as an elastic member (96) comprised of a layer having holes (see Figures 1

and 8-10). The elastic member provides an improved seal with the outer surface of the reaction vessel caps. The fluid manifold contains passages (42, 44) that allow for the addition of fluids (passage 42) as well as the removal of fluids (through passage (44) to and from the reactors while under pressure. The system also includes reaction vessels (16) having caps (54) that interact with the manifold to form a valve (column 9, lines 10-53). The Examiner considers the valve formed by the rotatable surface (70) of the cap to meet applicant's limitation of a "check valve" in the flow restriction device. It would have been obvious to one of ordinary skill in the art to add the manifold system and vials of Kilcoin to the device of Bisconte. One would add the manifold system of Kilcoin in order to individually pressurize and control the fluid flow in each well instead of simply pressurizing all the wells at once as currently done by Bisconte (col. 5, lines 46-61). One would add the vials in order to provide individual reactors that could be removed from the device for further examination.

5. Claims 26 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bisconte (5,190,666) and Kilcoin et al. (6,190,619), and further in view of Lebl et al. (6,045,755). Bisconte and Kilcoin, as combined above in paragraph 4, teach every element of claims 26 and 50 except for the biasing springs. Lebl teaches an apparatus for combinatorial chemistry. One embodiment of the device includes an array of independent reaction vessels sealed by balls. The cover of the reaction array includes spring elements for providing a force to urge the balls into a sealed configuration with the vessels (column 19, line 29 – column 21, line 22). It would have been obvious to

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combine the spring from Lebl with the combined teachings of Bisconte and Kilcoin. One would add the spring from Lebl to the combined reaction block of Bisconte and Kilcoin in order to provide an additional sealing force for the reaction vessels as taught by Lebl.

### ***Response to Arguments***

6. Applicant's arguments, filed 12/27/2004, with respect to the reference Maimon have been fully considered and are persuasive. The 102 rejection of claims 17, 21 and 23-25 as anticipated by Maimon has been withdrawn.

7. Applicant's arguments, filed 12/27/2004, with respect to the 102 rejection(s) of claim(s) 17, 19, 21, 23, 24, 42, 43, 45-47 and 54 under Bisconte have been fully considered and are persuasive. The Examiner agrees with applicant that plate 13A of Bisconte does not meet applicant's limitation of a "flow restriction device" as recited in the instant claims (applicant's arguments, page 18, lines 3-15). Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bisconte and Kilcoin et al.

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brenner et al. (6,537,500) teaches a reaction device for examining catalysts that can be used at high pressures.


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K. Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH  
April 4, 2005

  
Jill Warden  
Supervisory Patent Examiner  
Technology Center 1700